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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,317	06/30/2003	Dennis R. McKean	HSJ9-2003-0021US1	4010

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EXAMINER

CHEN, TIANJIE

ART UNIT PAPER NUMBER

2652

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/611,317	Applicant(s) MCKEAN ET AL.	
	Examiner Tianjie Chen	Art Unit 2652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 21-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20031117</u> . | 6) <input type="checkbox"/> Other: _____ |

Non-Final Rejection

Election/Restrictions

1. Applicant's election without traverse of claims 1-20 in the reply filed on 05/13/2005 is acknowledged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-14, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dai et al (US 2004/0093719) in view of Schriener et al (US 6,350,495)

Dai et al shows a slider assembly in Fig. 2 including a plurality of sliders 18 bonded by a debondable solid encapsulant 14 (Figs. 4-7; [0038], [0042], and [0046]), each slider has a surface 24 that is free from the encapsulant, and the encapsulant-free surfaces are coplanar to each other ([0037]).

Dai et al shows that the encapsulant is comprised of thermoplastics, such as Able Stick conductive Thermal Plastic Film ([0038], lines 7, and 12-14) or other polymers ([0038], lines 20-24), but does not specify styrene and butadiene polymers.

Schriener et al shows various thermoplastics, which include styrene and acrylate polymer (Column 5, lines 44-61).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to include styrene and acrylate polymer as material for

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encapsulant. The rationale is as follows: Dai et al shows that encapsulant can be thermoplastics, Dai et al also mentions some commercial brands and further opens door for other thermoplastics. Schriener et al shows various thermoplastics. One of ordinary skill in the art would have been motivated to include Schriener et al's thermoplastics as materials for encapsulant, which would include styrene and acrylate.

Claim 2, Dai et al further shows a contiguous planar surface 24 included at least one encapsulant region and containing the coplanar slider surfaces.

Claim 3, Dai et al further shows that the sliders 18 are arranged in an array (Fig. 2).

Claim 4, Dai et al further shows that the array is a rectilinear array (Fig. 2).

Claim 5, Dai et al further shows that the sliders do not contact each other (Fig. 2).

Claim 6, Dai et al further shows that the coplanar surfaces of the sliders are each an air-bearing surface ([0037], lines 7-8).

Claims 7 and 8, Dai et al further shows a substrate 30+28 in contact with the air-bearing surfaces; substrate is comprised of a laminate of a flexible tape 28 and an adhesive, wherein the adhesive is in contact with the air-bearing surfaces ([0037] lines 7-10).

Claim 9, Dai et al further shows that the slider assembly of claim 8, wherein the adhesive is a pressure sensitive adhesive ([0039], lines 26-31).

Claim 10, Dai et al further shows that the adhesive the tape 28 over the air bearing surfaces 24.

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Claim 11, Dai et al further shows that the encapsulant does not substantially outgas under vacuum since there is no bubble ([0039], lines 28-32).

Claim 12, Dai et al further shows a carrier 12 ([0038], line 1) attached to the encapsulant, wherein the carrier does not cover any of the coplanar slider surfaces.

Claim 13. Dai et al further shows a resist layer 14 on the air-bearing surfaces ([0041], lines 11-12), wherein the encapsulant is mechanically stable upon exposure to the resist layer or any component thereof.

Claims 14, Dai et al further shows that the encapsulant is subject to solvation by a solvent not found in the resist layer ([0042]).

Claims 17 and 18, Schriener et al shows acrylate polymer.

A "product by process" claim is directed to the product per se, no matter how actually made, see *In re Hirao*, 190 USPQ 15 at 17 (footnote 3 CCPC, 5/27/76); *In re Brown*, 173 USPQ 685 (CCPA 5/18/72); *In re Luck*, 177 USPQ 523 (CCPA, 4/26/73); *In re Fessmann*, 180 USPQ 324 (CCPA, 1/10/74); *In re Thorpe*, 227 USPQ 964 (CAFC, 11/21/85). The patentability of the final product in a "product by process" claim must be determined by the product itself and not the actual process and an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. In claims 17 and 18, the limitations of "is prepared via in situ polymerization of acrylate monomers" and "is prepared via photoinitiated polymerization of acrylate monomers" are process related limitations and gain no weight in determining patentability.

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3. Claims 15, 16, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dai et al in view of Schriener et al as applied to claim 4 above, and further in view of AAPA (Applicant admitted Prior Art).

Claims 15, 16, 19, and 20, AAPA shows in [0076] that a variety of low molecular weight hydrogenated styrene copolymers available from either ExxonMobile chemical company (Houston, Texas) or Arakawa Forest Chemical Industries, Ltd. Corporation (Osaka, Japan) have been studied. These materials are amorphous, soluble in nonpolar solvents and are available with softening points ranging from 70-150°C, preferably at least 130°C.

Dai et al and Schriener uses styrene encapsulant but does not specify the material. AAPA shows a commercial available material. It would have been obvious at the time the invention was made one of ordinary skill in the art would have been motivated to use the commercially available material. In thus constructed device, the solvent is comprised of a nonpolar solvent; the styrene polymer is a hydrogenated styrene copolymer, the hydrogenated styrene copolymer has a softening temperature of about 70° C to about 150° C, the softening temperature is at least about 130° C.

Note: AAPA teaches away from these features. The reason is not clear why Applicant recites these features as his invention.

Conclusion

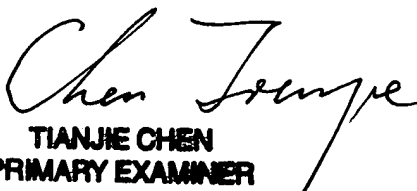
4. The prior art made of record in PTO 892 Form and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tianjie Chen whose telephone number is 571-272-7570. The examiner can normally be reached on 8:00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on 571-272-7579. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


TIANJIE CHEN
PRIMARY EXAMINER